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OFFICE OF PETITIONS

In re Application of :
Mitchell Berman :
Application No. 10/804,250 : **DECISION ON PETITION**
Filed: March 19, 2004 :
Attorney Docket No. 5199-85 :

This is a decision on the petition, filed March 3, 2008, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition to withdraw the holding of abandonment is **Dismissed**.

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This application was held abandoned for failure to reply to the non-final Office action mailed June 22, 2007, which set a three (3) month shortened statutory period for reply. This decision precedes the mailing of a Notice of Abandonment.

Petitioner asserts that the Office action dated June 22, 2007 was not received. Petitioner contends a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address was mailed January 20, 2006. In support of petitioner's argument, petitioner has provided a copy of a postcard and a transmittal form, which contains a certificate of mailing dated January 20, 2006. Petitioner argues that the Office action was not received because the change of address was not entered and the Office action was mailed to the incorrect address.

Pursuant to 37 CFR 1.8, correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted

correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. The Office may require additional evidence to determine if the correspondence was timely filed.

Petitioner has failed to meet requirement (3). In order to establish that the June 22, 2007 Office action was mailed to the incorrect address; petitioner needs to provide additional information. Petitioner must provide a statement which attest on personal knowledge that the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address was mailed on January 20, 2006. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). A review of the certificate of mailing shows that Paul Ragusa executed it. Mr. Ragusa has not provided a statement nor has Attorney Schalk provided a sufficient statement.

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt, which itemizes and properly identifies the items, which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. The postcard provided to establish prior receipt of the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address does not serve as prima facie evidence because it does not contain the Office stamp.

Further, a review of the recorded assignment documents does not show the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence was inadvertently recorded.

If petitioner is unable to establish the Office action was mailed to the incorrect address. Petitioner may wish to file a petition under 37 CFR 1.137(b). A courtesy copy of the June 22, 2007 Office action is being provided for petitioner convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300

By delivery service:
(FedEx, UPS, DHL, etc.)

U.S. Patent and Trademark Office
Customer Service Window,
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

A handwritten signature in black ink, appearing to read "Charlema Grant", with a long horizontal flourish extending to the right.

Charlema Grant
Petitions Attorney
Office of Petitions



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,250	03/19/2004	Mitchell F. Berman	5199-85	7474
<div>7590 06/22/2007</div> <div>Leslie Gladstone Restaino, Esq. Brown Raysman Millstein Felder & Steiner LLP 163 Madison Avenue, P.O. Box 1989 Morristown, NJ 07962-1989</div>				
			EXAMINER	
			MATTER, KRISTEN CLARETTE	
			ART UNIT	PAPER NUMBER
			3771	
			MAIL DATE	DELIVERY MODE
			06/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,250	Applicant(s) BERMAN, MITCHELL F.	
	Examiner Kristen C. Matter	Art Unit 3771	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

In the present case, "37 CFR 1.56(a)" should be replaced with --37 CFR 1.56--.

Drawings

The drawings are objected to because on Figure 1, reference character "104" is shown twice, once without actually identifying any structure. In addition, Figures 2-4 do not have any reference characters, making it unclear what is being shown in the figure, where the claimed elements are located, and how the parts fit together.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 2 is objected to because of the following informalities: on line 1, "adopted" should be replaced with --adapted-- to fix the typographical mistake. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the present case, claim 1 recites that the display is mounted "so as not to protrude from the frame". This is not supported in the specification because as clearly seen from figure 1, the displays protrude from the top of the frame. Claims 2-10 are dependent on claim 1 and are therefore rejected for the reasons outlined above with respect to claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, it is unclear as to whether the display is part of the anesthesia machine or a separate element because the claim recites that the display is “adjustably attached to the frame” on line 2, but also recites that the display is mounted “in the anesthesia machine” on line 3. Claims 2-10 are dependent on claim 1 and are therefore rejected for the reasons outlined above with respect to claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Phoon et al. (US 2002/0013640).

Regarding claims 1, 5, and 7, Phoon et al. disclose an apparatus for hold anesthesia comprising at least one display (118) and keyboard (120) adjustably attached to a frame (102) so that the display does not protrude from the frame. The apparatus is considered an “anesthesia

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machine” inasmuch as the apparatus is a machine and is used with anesthesia and is adapted for use in an operating room (paragraph 0015).

Regarding claims 2 and 9, Phoon et al. disclose that the display is adapted for patient monitoring and automated record keeping (paragraph 0015).

Regarding claims 3 and 4, Phoon et al. discloses that the display is able to tilt and move in an up-down direction with respect to the frame (See Figures 4A and 4B).

Regarding claim 10, Phoon et al. discloses computing programs associated for capturing patient preoperative data and operative data (paragraph 0015 and Figure 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phoon et al. as applied to claims 1-5, 7, 9, and 10 above and further in view of Tsai (US 6,644,874). Phoon et al. is silent as to the keyboard being waterproof. Tsai discloses a waterproof keyboard (column 1, line 60-column 2, line 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the keyboard disclosed by Phoon et al. waterless as taught by Tsai in order to protect the keyboard from water damage that may occur in the operating room.

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Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phoon et al. as applied to claims 1-5, 7, 9, and 10 above and further in view of Huilgol et al. (US 5,708,561). Although Phoon et al. discloses a mounting arm (124) having one end adjustably attached to the display and the other end adjustably attached to the frame, Phoon et al. is silent as to a horizontal sliding track to provide movement in a fore and aft or left and right movement. Huilgol et al. disclose a computer (display/keyboard assembly) with a horizontal sliding track (56) that is able to provide movement in at least one of a fore and aft or left and right direction depending on the orientation of the mounting arm (see figure 6 and column 5, line 60-column 6, line 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Phoon et al.'s display with a horizontal sliding track as taught by Huilgol et al. in order to allow the computer screen to swivel from a portrait to landscape orientation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clark et al. and Ido et al. are cited to show other sliding tracks. Schreiber et al., Roberts, and Blair et al. are cited to show other anesthesia machine frames with adjustable displays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Matter whose telephone number is (571) 272-5270.


The examiner can normally be reached on Monday - Friday 9-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kristen C. Matter
Examiner
Art Unit 3771


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700
6/18/07